

REMARKS/DISCUSSION OF ISSUES

Claims 1 through 9 are pending in the application. Claims 1 through 9 are rejected.

Claims 1, 2 and 4-9 are rejected under 35 USC 103(a) as being unpatentable over Steeger in view of Opitz.

Steeger discloses a low-pressure mercury gas discharge lamp comprising a transparent inner bulb coated with a phosphor, which forms a gas discharge vessel, and comprising an outer bulb surrounding and spaced apart from the inner bulb.

Steeger does not disclose or suggest that the outer bulb may also comprise a phosphor.

Opitz is cited to show the use of specific phosphor compositions as coatings in a lighting device. However, Opitz teaches that these phosphors are used for the emission of visible (red, green and blue) light (See col. 3, lines 28-32), and nowhere teaches or suggests that these phosphors would be suitable for the absorption of UV-A.

While some of the phosphors listed by Opitz are UV-A phosphors, others are not. There is simply no teaching by Opitz which would lead the skilled artisan to choose certain phosphors from the list, while rejecting others, without the hindsight gained from Applicants' teachings regarding the harmful effect of UV-A radiation. Such hindsight is not permitted in judging obviousness under Section 103.

The Examiner has acknowledged that Opitz does not recognize that some of his phosphors are UVA phosphors, but urges that UVA absorption is an inherent characteristic of the disclosed materials.

However, Opitz uses the phosphors for their visible light emission characteristics, and lacks any suggestion which could

provide guidance or motivation to the skilled artisan to choose any particular phosphor because of its UVA characteristics.

The only guidance for choosing phosphors having UVA characteristics is taught by Applicant. The use of such guidance in judging patentability under Section 103 is not permitted by law.

In the Final Office action, the Examiner states that hindsight was not used because the motivation to combine the references is applicable to all of the phosphors listed by Opitz.

This position seemingly confuses the differing standards for patentability under Sections 102 (anticipation) and 103 (obviousness). In the case of anticipation, a single phosphor from a list can be held to be anticipatory of a claimed phosphor of the same composition.

However, in the case of obviousness, it has been held that at least one of the references must contain at least a suggestion sufficient to motivate the skilled artisan to combine the references in a manner to render obvious the claimed invention.

In the present case, neither reference contains any suggestion which would lead the skilled artisan to select one of the phosphors from Opitz which has inherent UVA characteristics. The combination fails for that reason alone.

However, the combination further fails because what is claimed is not just a lamp with a UVA phosphor, but a lamp with an inner bulb with a phosphor and an outer bulb with a UVA phosphor.

While Steeger discloses a lamp with inner and outer bulbs, only the inner bulb has a phosphor coating. Opitz does not

disclose any lamp structure, nor does Opitz contain any teaching regarding where a phosphor should be placed in a lamp.

Thus, even if the skilled artisan happened to choose a phosphor of Opitz having UVA characteristics, the references would still fail to suggest the claimed lamp structure.

Accordingly, it is urged that the rejection of claims 1, 2 and 4-9 under 35 USC 103(a) as being unpatentable over Steeger in view of Opitz is in error, and should be withdrawn.


Claim 3 is rejected under 35 USC 103(a) as being unpatentable over Steeger in view of Opitz in further view of Nishio.

Nishio is cited to show an outer bulb made of resin. Without conceding the patentability per se of claim 3, this claim is nevertheless patentable by virtue of its dependency on claim 1.

Accordingly, it is urged that the rejection of claim 3 under 35 USC 103(a) as being unpatentable over Steeger in view of Opitz in further view of Nishio is in error, and should be withdrawn.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance.

Respectfully submitted,

  
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